

REMARKS

Status of the Claims

Claims 1-20 are pending, with claims 1 and 18 being independent. Claim 12 has been amended to correct a minor typographical error. No new matter has been added.

Initially, Applicants would like to thank Examiner Goodrow for indicating that claims 6-8 would be allowable if rewritten independent form including all the limitations of the base claim and any intervening claims.

The undersigned would also like to thank Examiner Goodrow for the courtesies extended during the telephonic interview conducted on July 14, 2006. In accordance with M.P.E.P. § 713.04, during the interview, the pending rejection of Claims 1-5 and 9-20 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 4,954,412 ("Breton") in view of U.S. Patent No. 6,130,290 ("Troy") was discussed. Specifically, Examiner Goodrow indicated that Troy appeared to be non-analogous art and that the proposed combination of Breton and Troy was not relevant to the limitations recited in independent Claim 1.

Applicants respectfully request reconsideration and withdrawal of the outstanding rejection in view of the telephone interview and the following remarks.

Claim Rejection Under 35 U.S.C. § 103

As noted above, Claims 1-5 and 9-20 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Breton in view of Troy. Applicants respectfully disagree with the rejection; therefore, this rejection is respectfully traversed.

Breton is cited as teaching: (1) an encapsulated toner composition having a liquid crystalline shell, and (2) polyurethanes and polyesters as thermotropic crystalline shell. (Office Action, Page 2).

Troy is cited as teaching: (1) crystalline impact modifiers as a shell of a crystalline vinyl copolymer, (2) that the degree of crystallinity is controlled by the cooling cycle, and (3) that various dyes and pigments can be added to the core shell structure. (Office Action, Page 2).

The Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success "to impact modifiers for an amorphous polyester and utilize it in a toner composition having a core/shell structure to obtain the same improvement to the toner particle." (Office Action, Pages 2-3).

TO RELY ON A REFERENCE UNDER 35 U.S.C. § 103, IT MUST BE ANALOGOUS PRIOR ART

As noted in M.P.E.P. § 2141.01(a), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Troy relates to an impact modifier composition which provides an improved balance of impact resistance and optical clarity to amorphous aromatic polyester resin. (Column 1, Lines 8-11). More specifically, Troy discloses that certain core-shell (polymer) impact modifiers produce clear, and unexpectedly tough blends with amorphous aromatic polyesters. (Column 3, Lines 54-56). The blends may be used to produce molded parts, bottles, sheet, films, pipes, foams, containers, profiles, or other articles. (Column 3, Lines 47-50).

Applicants respectfully submit that Troy, directed to blends of core-shell (polymer) impact modifiers and amorphous aromatic polyesters used to produce molded parts, bottles, sheet, films, pipes, foams, containers, profiles, or other articles, is non-analogous art to the presently claimed electrostatic latent-image developing toner comprising a core particle and a shell layer comprising a crystalline polyester resin formed on an outer portion thereof. Accordingly, Applicants respectfully submit that non-analogous Troy may not be relied upon as a basis for rejection of Applicants' claims.

PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS

As noted in M.P.E.P. § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

As noted above, non-analogous Troy relates to an impact modifier composition which provides an improved balance of impact resistance and optical clarity to amorphous aromatic polyester resin. (Column 1, Lines 8-11). Non-analogous Troy discloses that an amorphous polyester may contain a small amount of crystallinity, but the level must be low enough so that clarity is not adversely affected. (Column 1, Lines 52-54). Non-analogous Troy further

discloses that it is important that *no crystallization promoter* is present in the impact modifier composition since Troy is directed to compositions suitable for producing *amorphous, non-crystalline* articles. (Emphasis added; Column 7, Lines 44-47).

Accordingly, Applicants respectfully submit that non-analogous Troy teaches away from the presently claimed electrostatic latent-image developing toner comprising a core particle and a shell layer comprising a *crystalline* polyester resin formed on an outer portion thereof.

BASIC REQUIREMENTS OF A PRIMA FACIE CASE OF OBVIOUSNESS

As noted in M.P.E.P. § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that there is neither any suggestion or motivation, either in Breton or non-analogous Troy themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Breton and non-analogous Troy, nor a reasonable expectation of success. As noted above, non-analogous Troy, directed to blends of core-shell (polymer) impact modifiers and amorphous aromatic polyesters used to produce molded parts, bottles, sheet, films, pipes, foams, containers, profiles, or other articles, discloses that it is important that no crystallization promoter is present in the impact modifier composition since Troy is directed to compositions suitable for producing amorphous, non-crystalline articles. In contrast, Breton is directed to processes for encapsulated toner compositions wherein the shells thereof are comprised of, for example, thermotropic liquid crystalline components. (Column 1, Lines 11-16).

Applicants further respectfully submit that even if there were some suggestion or motivation, either in Breton or non-analogous Troy themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Breton and non-analogous Troy, and a

reasonable expectation of success, Breton in view of non-analogous Troy does not disclose or suggest all the claim limitations. In particular, Breton in view of non-analogous Troy does not disclose or suggest the presently claimed electrostatic latent-image developing toner comprising a core particle and a shell layer comprising a crystalline polyester resin, having a softening point from 60 to 120°C at 70 to 100% by weight of the entire shell-layer constituent resin, formed on an outer portion thereof.

As disclosed the present specification,

the term "crystalline" . . . means that the ratio . . . of the softening point to the melting point of the resin is not less than 0.9 to not more than 1.1. In the present invention, the ratio depends on the monomer composition of the resin, and is hardly dependent on conditions, such as a cooling rate, at the time of synthesizing the resin. Those resins having the ratio out of the above-mentioned range are defined as "amorphous."

(Paragraph [0026]). Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Conclusion

For the reasons noted above, the art of record does not disclose or suggest the inventive concept of the present invention as defined by the claims. In view of the foregoing remarks, reconsideration of the claims and allowance of the subject application is earnestly solicited. In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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